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09/863,749

05/23/2001

Tadashi Fukumoto

Ishii Case 16

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7590 12/20/2007
FLYNN, THIEL, BOUTELL & TANIS, P.C.
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EXAMINER

SPAHN, GAY

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* TADASHI FUKUMOTO and TSUYOSHI HASHIMOTO
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11 Appeal No. 2007-1342
12 Application No. 09/863,749
13 Technology Center 3700
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16 Decided: December 20, 2007
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19 Before WILLIAM F. PATE, III, HUBERT C. LORIN, and JENNIFER D. BAHR,
20 *Administrative Patent Judges*.

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22 PATE, III, *Administrative Patent Judge*.

23
24
25 DECISION ON APPEAL
26

27 This is an appeal from the Final Rejection of claims 15, 18, 21, and 23-24,
28 and from the Examiner's refusal to allow claims 13 and 16 as amended after final
29 rejection. Claims 6, 7, 12, 22, 25, and 26 stand allowed. Claims 14 and 17 stand
30 objected to as directed to allowable subject matter, and claims 1-5, 8-11, 19 and 20
31 have been canceled.

32 We have jurisdiction under 35 U.S.C. §§ 134 and 6.

33 The claimed invention is directed to a submerged breakwater to act as an
34 artificial reef near the shoreline of the ocean. The breakwater generally comprises

1an open box having a vertical wall on the offshore side, the top of the box is
2characterized by inclined slits.

3 Claim 13, reproduced below, is further illustrative of the claimed subject
4matter.

5 13. A submerged breakwater generating structure comprising an open
6 box having a vertical wall for producing a breakwater at an offshore side,
7 said vertical wall having at least one opening at a lower end and slits
8 inclined with respect to the direction along which waves propagate
9 disposed at the top portion of said box and having openings provided in a
10 spaced-apart relationship between said vertical wall and a second vertical
11 wall of said open box.
12

13 The reference of record relied upon by the Examiner as evidence of
14anticipation and obviousness is:

15 Yamamoto¹(as translated) JP-55110520 Aug. 2, 1980
16

17 Claims 13, 15, and 21 stand rejected under 35 U.S.C. § 102 as anticipated by
18JP 55-110520.

19 Claims 16, 18, 23, and 24 stand rejected under 35 U.S.C. § 103 as
20unpatentable over JP 55-110520.

21 We have carefully reviewed the rejections on appeal in light of the
22arguments of the Appellants and the Examiner. As a result of this review, we have
23determined that the Examiner has not established the lack of novelty or the prima
24facie obviousness of the claims on appeal. Therefore the rejections on appeal are
25reversed.

26 OPINION

27 The law with respect to preambles is well settled. Preamble language that
28merely states the purpose or intended use of an invention is generally not treated as
29limiting the scope of the claim. *See Boehringer Ingelheim Vetmedica, Inc. v.*

4¹Hereinafter referred to as JP 55-110520.

1*Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003); *Rowe v. Dror*, 112
2F.3d 473, 478 (Fed. Cir. 1997). However, the preamble is regarded as limiting if it
3recites essential structure that is important to the invention or necessary to give
4meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-
506 (Fed. Cir. 2005), *cert. denied*, 74 U.S.L.W. 3421 (U.S. Jan. 23, 2006); *SanDisk*
6*Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1284 n.2 (Fed. Cir. 2005), *cert.*
7*denied*, 126 S.Ct. 829 (2005).

8 For example, in *Rowe v. Dror*, a catheter claimed in the preamble as a
9“balloon angioplasty catheter” was held by our reviewing court to be patentable
10over a catheter of general utility even though this description of the claimed subject
11matter appeared only in the preamble to the claim. Therein, the court stated that
12the

13 claim preamble has the import that the claim as a whole suggests for it.
14 Where a patentee uses the claim preamble to recite structural limitations of
15 his claimed invention, the PTO and courts give effect to that usage.
16 Conversely, where a patentee defines a structurally complete invention in the
17 claim body and uses the preamble only to state a purpose or intended use for
18 the invention, the preamble is not a claim limitation [citations omitted].
19

20 *Rowe v. Dror*, 112 F.3d at 478. In essence, the court examined the entire
21specification and the arguments and found that the preambular recitation was, in
22fact, a structural limitation of Rowe’s claimed subject matter.

23 In the present case, our review of the record as a whole, including
24Appellants’ disclosure and arguments on appeal, reveals that the recitation of a
25“submerged breakwater” is directed to the kind or type of breakwater Appellants
26are claiming and should be regarded as a structural limitation. We do not regard
27this as a mere intended use as the Examiner has suggested. When Appellants
28indicate by argument and amendment that they are to be bound by the preambular

1structural limitations, then these limitations should be given full weight in the
2examination process. That is, if the claim drafter “chooses to use *both* the
3preamble and the body to define the subject matter of the claimed invention, the
4invention so defined, and not some other, is the one the patent protects.” *Bell*
5*Commc'ns Research, Inc. v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 620 (Fed. Cir.
61995).

7 In the instant case the applied reference is not directed to a submerged
8breakwater as admitted by both the Appellants and the Examiner. The Yamamoto
9breakwater has the low front side submerged and the high rear side extending
10above the water surface. (Yamamoto, page 5, ll. 10-12). Waves are intended to
11break on the concrete swash-plate 2. (Yamamoto, page 7, ll. 16-22). Thus, the
12Examiner’s argument (Answer 7:7) that the breakwater of the applied reference is
13capable of performing as a submerged breakwater is based on speculation.
14Therefore, the reference does not anticipate the subject matter of Appellants’
15claims. With respect to obviousness, the Examiner points to no evidence that it
16would have been obvious to use the breakwater of the applied reference as a
17submerged breakwater. Accordingly, the obviousness rejection can not be
18sustained.

19 Furthermore, we disagree with the Examiner’s contention in the
20Supplemental Answer that the claims are not directed to a “fully submerged
21breakwater.” (Supplemental Answer 1:11). The ordinary and customary meaning
22of “submerged” is under water. Finally, we disagree with the Examiner’s
23contention that placing the breakwater of the applied reference on a mound, as
24called for in claims 16 and 24, would have been *prima facie* obvious. There is no
25evidence to support such a legal conclusion on the part of the Examiner.

17Appeal 2007-1342
18Application 09/863,749
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REVERSED

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